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ASHKAN NAJAFI, P.A.
6817 SOUTHPOINT PARKWAY
SUITE 2301
JACKSONVILLE, FL 32216

EXAMINER

WRIGHT, ANDREW D

ART UNIT PAPER NUMBER

3617

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/803,596

Applicant(s)

KEPKA, ROBERT THOMAS

Examiner

Andrew Wright

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/18/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Objections

1. Claims 2-6, 9-13, and 15-18 are objected. Appropriate correction is required.
2. Claim 2 recites "a water vehicle transom" after the same element has already been positively recited in claim 1. The recitation in claim 2 should be "the water vehicle transom" to avoid confusion of a double recitation. Claims 9 and 15 have similar recitations.
3. Claim 3 recites "said another shaft". This recitation lacks antecedent basis in the claims. It will be assumed that this refers to the "another said plurality of shafts". Consistent terminology should be used. Claim 10 has a similar recitation.
4. Claim 4 recites "the water vehicle outdrive". This recitation lacks antecedent basis in the claims. It will be assumed that this refers to the "the outdrive system". Consistent terminology should be used. Claims 11 and 16 have similar recitations.
5. Claim 5 recites "the boat transom" in two places. This recitation lacks antecedent basis in the claims. It will be assumed that this refers to the "the water vehicle transom". Consistent terminology should be used. Claims 12 and 17 have similar recitations.
6. Claim 6 recites "wherein said support means further comprises". No structure of the support means has been recited. Use of the word "further" is confusing. It is requested that applicant clarify if this claim is intended to depend from claim 1 or claim 5. For examination it will be assumed to depend from claim 1, as written, and the word "further" will be ignored. Claims 13 and 18 have similar recitations.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 2, 3, 9, 10, and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 2 recites "for transferring a first linear motion of one said plurality of shafts to a second linear motion of another said plurality of shafts". The disclosure does not describe how the shafts transfer linear motion. The shafts transfer rotational motion. Claim 3 depends from claim 2 and is rejected for the same reason. Claims 9 and 15 has similar recitations.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
11. Claim 1 recites "control means for generating a user input and directing the outdrive system" in line 3. This recitation invokes 35 USC 112, 6th Paragraph, because it: (a) uses the phrase "means for"; (b) modifies the phrase "means for" with functional

language; and (c) does not modify the phrase "means for" with structure for achieving the function. From MPEP 2181:

35 U.S.C. 112, sixth paragraph states that a claim limitation expressed in means-plus-function language "shall be construed to cover the corresponding structure...described in the specification and equivalents thereof." "If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112." *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (in banc).

The disclosure does not identify the corresponding structure that performs the recited function of claim 1. The specification does not use the term "control means". There are numerous elements that conceivably assist in performing the function, and it is unclear exactly which are intended to be included in the "control means" and which are not. Since the corresponding structure is not identified, it is impossible for the skilled artisan to determine the corresponding structure and its equivalents. 35 USC 112 6th Paragraph states that: "such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." If one cannot determine the corresponding structure and equivalents thereof, then one cannot determine the statutory scope of the claim coverage. Thus the claim is indefinite. Therefore the claim fails to satisfy 35 USC 112 2nd Paragraph. Claims 2-7

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depend from claim 1 and are rejected for the same reason. Claims 8-18 contain the same recitation.

12. Claim 1 further recites "support means for assisting to maintain said gimbal section at a substantially stable position during operating conditions". This recitation invokes 35 USC 112, 6th Paragraph, because it: (a) uses the phrase "means for"; (b) modifies the phrase "means for" with functional language; and (c) does not modify the phrase "means for" with structure for achieving the function. The disclosure does not identify the corresponding structure that performs the recited function of claim 1. Since the corresponding structure is not identified, it is impossible for the skilled artisan to determine the corresponding structure and its equivalents. 35 USC 112 6th Paragraph states that: "such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." If one cannot determine the corresponding structure and equivalents thereof, then one cannot determine the statutory scope of the claim coverage. Thus the claim is indefinite.

Therefore the claim fails to satisfy 35 USC 112 2nd Paragraph. Claims 2-7 depend from claim 1 and are rejected for the same reason. Claims 8-18 contain the same recitation.

13. Claim 14 recites the limitation "said another shaft" in line 9. There is insufficient antecedent basis for this limitation in the claim. This renders the claim indefinite.

Claims 15-18 depend from claim 14.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claim 1-3, 6, 8-10, 13-15, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Hosoi (US 5,647,780). Hosoi shows a gimbal assembly for an outdrive. Hosoi discloses a steering cylinder and circuit (column 3, lines 36-41). The steering system and circuit constitute a control means for generating a user input and directing the outdrive system to rotate freely in a selected radial path. Hosoi shows gimbal housing (32) and gimbal ring (34) that constitute the gimbal section. Hosoi discloses that the steering cylinder is connected to the gimbal housing. Hosoi shows cylinders (84, 114) that constitute a support means for assisting to maintain the gimbal section at a stable position during operation. The cylinders are connected at least indirectly to the transom.

16. Claim 2, Hosoi shows an upper housing (22) extending from the transom comprising first shaft (54) and second shaft (58) and bevel gear (56). The shafts are substantially orthogonal to each other (fig 4).

17. Claim 3, Hosoi shows universal gear (60) connected to the shaft (58) such that the outdrive can be rotated clockwise and counterclockwise.

18. Claim 6, the support means comprises cylinders (84, 114) and pumps (100, 120).

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19. Hosoi as, described above, discloses the limitations recited in claims 8-10, 13-15, and 18.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 1, 4, 8, 11, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hosoi (US 5,647,780). Hosoi discloses the elements of claim 1. Hosoi does not disclose a steering gear. Hosoi discloses that the steering cylinder is operated and controlled by conventional mechanisms, but does not specify the mechanisms. It is well known and common for steering mechanisms to comprise a steering gear. Typically a gear can be found in the users control and in a pump that actuates the steering cylinders. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hosoi by providing a steering gear. The motivation would be to provide a known conventional mechanism as suggested by Hosoi. The same applies for claims 11 and 16.

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Johnson ('685) shows an outdrive with a gimbal unit comprising

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three bevel gears. Mathewson ('597) shows an outdrive with a universal joint arranged on a vertical drive shaft. Nossiter ('558) shows an outdrive with a gimbal unit and support mechanism. Blanchard ('348) shows an outboard with a universal joint arranged on a vertical drive shaft. Livingston et al. ('325) shows a motor with a universal joint arranged on a vertical drive shaft.

23. Any inquiry concerning this communication should be directed to examiner Andrew D. Wright at telephone number (703) 308-6841. The examiner can normally be reached Monday-Friday from 9:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano, can be reached at (703) 308-0230. The fax number for official communications is 703-872-9306. The fax number directly to the examiner for unofficial communications is 703-746-3548.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew D. Wright
Patent Examiner
Art Unit 3617

AW 11/11/04
ANDREW D. WRIGHT
PRIMARY EXAMINER